



IFW

Docket No.: SON-2842
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takashi Aoki et al.

Application No.: 10/526,490

Confirmation No.: 7483

Filed: March 4, 2005

Art Unit: 2624

For: IMAGE PROCESSING APPARATUS AND
IMAGE PROCESSING METHOD

Examiner: N. Bitar

REQUEST TO WITHDRAW ERRONEOUS NOTICE OF ABANDONMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Va 22313-1450

Sir:

The Applicant, through its attorneys, hereby requests withdrawal of the erroneous Notice of Abandonment mailed in the above-identified application on February 10, 2004. No fee is believed required to support this request. However, if a fee is required, the Commissioner is hereby authorized to charge the fee to Deposit Account # 18-0013.

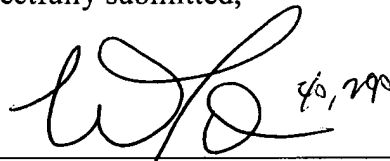
In the Notice of Abandonment of December 11, 2008, the Office alleged that Applicant failed to timely respond to the FINAL Office Action of April 28, 2008. This is incorrect as evidenced by the enclosed copy of the Notice of Appeal and Pre-Appeal Brief Request for Review filed September 23, 2008, together with a copy of the postcard receipt stamped "September 23, 2008" by the U.S. Patent Office. This stamped postcard receipt is competent evidence that the Notice of Appeal and the Pre-Appeal Brief Request for Review were timely filed. Thus the Notice of Abandonment is in error.

Further evidence of the erroneous nature of the Notice of Abandonment is evidenced by the last paragraph of the Decision on Petition as mailed October 27, 2008, which states "the application is being forwarded to the Technology Center for processing and consideration of the Pre-Appeal Brief Request for review and petition to withdraw restriction requirement simultaneously filed September 23, 2008."

Applicant respectfully requests an official withdrawal of the Notice of Abandonment and a prompt issuance of the allowed application.

Prompt action on this matter is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Kananen', with the date '4/10, 2008' written to its right.

Ronald P. Kananen
Registration No. 24,104
Christopher M. Tobin
Registration No. 40,290

Dated: December 17, 2008

RADER, FISHMAN & GRAUER PLLC
1233 20TH Street, NW
Suite 501
Washington, DC 20036
Telephone: (202) 955-3750
Facsimile: (202) 955-3751
Customer No. 23353



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,490

03/04/2005

Takashi Aoki

SON-2842

7483

23353 7590 12/11/2008
RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

BITAR, NANCY

ART UNIT

PAPER NUMBER

2624

MAIL DATE

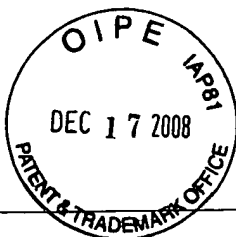
DELIVERY MODE

12/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Notice of Abandonment

Application No.

10/526,490

Examiner

NANCY BITAR

Applicant(s)

AOKI ET AL.

Art Unit

2624

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 28 April 2008.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

No reply has been filled.

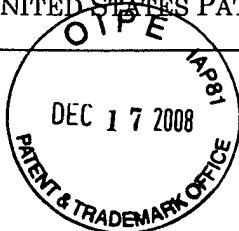
/Jingge Wu/
Supervisory Patent Examiner, Art Unit 2624

/Nancy Bitar/
Examiner, Art Unit 2624

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
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RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON DC 20036

MAIL

OCT 27 2008
DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of: :
AOKI, TAKASHI et al :
Application Serial No.: 10/526,490 :
Filed: March 04, 2005 :
For: **IMAGE PROCESSING APPARATUS AND** :
IMAGE PROCESSING METHOD :

DECISION
ON PETITION

This is a decision on the petition, filed on August 6, 2008 under 37 C.F.R. §1.181 to withdraw holding of Non-Compliance Notice mailed on July 25, 2008.

Petitioner states in part "Please note that the requirements of 37 C.F.R. § 1.121 set forth the manner of making *amendments* in an application. ... The status identifier (withdrawn - currently amended) is also acceptable for a withdrawn claim that is being currently amended. ... The Notice of Non-Compliance cites the basis for non-compliance as being that:

Claim 7 and 13 are non-compliant claims because they recites two labels (WITHDRAWN and CURRENTLY AMENDED) at the same time while one label is required.

Applicant notes that this basis is cited despite the fact that the face of the Notice of Non-Compliance clearly indicates that status identifiers may be any "*one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).*" "

BACKGROUND

An Amendment after final rejection was filed on June 11, 2008. As part of the amendment after final, applicant used the status identifier (Withdrawn – Currently Amended) for claims 7 and 13.

On July 25, 2008, a Notice of Non-Compliant Amendment (37 CFR 1.121) and Advisory Action were simultaneously mailed to the applicant. The Notice of Non-Compliant Amendment stated "Claim 7 and 13 are non-compliant claims because they recite two labels (WITHDRAWN and CURRENTLY AMENDED) at the same time while one label is required."

37 CFR § 1.121(c)(2) states in part:

If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn — currently amended."

MPEP § 714(II)(C)(A) states:

(A) Status Identifiers: The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following status identifiers: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). The status identifier (withdrawn – currently amended) is also acceptable for a withdrawn claim that is being currently amended. See paragraph (E) below for acceptable alternative status identifiers.

Applicant's use of the Status identifier (Withdrawn – Currently Amended) is clearly within the boundaries set forth by the Patent Rules and MPEP.

The request for withdrawal of the Non-Compliant Amendment (37 C.F.R. 1.121) notice mailed on July 25, 2008 is **Granted**.

Amendment after final rejection has already been considered by the examiner as evidenced by the Advisory Action mailed July 25, 2008. Therefore, the application is being forwarded to the Technology Center for processing and consideration of the Pre-Appeal Brief Request for review and petition to withdraw restriction requirement simultaneously filed September 23, 2008.



Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications



Atty Docket No.: SON-2842
(Son-2842)

Inventor: Takashi AOKI, et al.

Application No.: 10/526,490-Conf. #7483 Filing Date: March 4, 2005
Title: IMAGE PROCESSING APPARATUS AND IMAGE PROCESSING METHOD

Documents Filed:

Fee Transmittal (1 page)

Two Month Request for Extension of Time Under 37 CFR 1.136(a) (1 page)

Notice of Appeal (1 page)

Pre-Appeal Brief Request for Review (1 page)
Written Summary (5 pages)

Petition under 37 C.F.R. 1.144 (6 pages)

Charge \$970.00 to deposit account 18-0013

Via: Courier

Sender's Initials: CMT/NMZ/ajh

Date: September 23, 2008

2

Atty Docket No.: SON-2842
(Son-2842)

Inventor: Takashi AOKI, et al.

Application No.: 10/526,490-Conf. #7483 Filing Date: March 4, 2005
Title: IMAGE PROCESSING APPARATUS AND IMAGE PROCESSING METHOD

Documents Filed:

Fee Transmittal (1 page)

Two Month Request for Extension of Time Under 37 CFR 1.136(a) (1 page)

Notice of Appeal (1 page)

Pre-Appeal Brief Request for Review (1 page)
Written Summary (5 pages)

Petition under 37 C.F.R. 1.144 (6 pages)

Charge \$970.00 to deposit account 18-0013



Via: Courier

Sender's Initials: CMT/NMZ/ajh

Date: September 23, 2008

2



PTO/SB/17 (10-07)


Approved for use through 06/30/2010. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).		Complete if Known	
FEE TRANSMITTAL For FY 2008		Application Number	10/526,490-Conf. #7483
		Filing Date	March 4, 2005
		First Named Inventor	Takashi AOKI, et al.
		Examiner Name	N. Bitar
		Art Unit	2624
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	SON-2842
TOTAL AMOUNT OF PAYMENT		(\$)	970.00

METHOD OF PAYMENT (check all that apply)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card
<input type="checkbox"/> Money Order	<input type="checkbox"/> None
<input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: 18-0013
Deposit Account Name: Rader, Fishman & Grauer PLLC	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

FEE CALCULATION							
1. BASIC FILING, SEARCH, AND EXAMINATION FEES							
	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fees Paid (\$)
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	
2. EXCESS CLAIM FEES							
Fee Description						Small Entity	
						Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims			
- =		x	=	Fee (\$)		Fee Paid (\$)	
HP = highest number of total claims paid for, if greater than 20.							
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)				
- =		x	=				
HP = highest number of independent claims paid for, if greater than 3.							
3. APPLICATION SIZE FEE							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)			
- 100 =		/50 =	(round up to a whole number) x	=			
4. OTHER FEE(S)							
Non-English Specification, \$130 fee (no small entity discount)							
Other (e.g., late filing surcharge): 1252 Extension for response within second month						460.00	
1401 Notice of appeal						510.00	

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	24,104 40,290
Name (Print/Type)	Ronald P. Kananen / Christopher M. Tobin		Telephone (202) 955-3750
			Date September 23, 2008



PTO/SB/22 (08-08)

Approved for use through 09/30/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

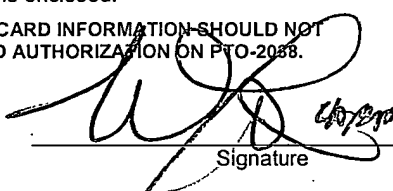
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

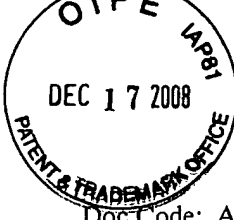
PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2008 (Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)		Docket Number (Optional) SON-2842	
Application Number 10/526,490-Conf. #7483		Filed	March 4, 2005
For IMAGE PROCESSING APPARATUS AND IMAGE PROCESSING METHOD			
Art Unit 2624		Examiner	N. Bitar
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application. The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):			
		<u>Fee</u>	<u>Small Entity Fee</u>
<input type="checkbox"/>	One month (37 CFR 1.17(a)(1))	\$120	\$60
<input checked="" type="checkbox"/>	Two months (37 CFR 1.17(a)(2))	\$460	\$230
<input type="checkbox"/>	Three months (37 CFR 1.17(a)(3))	\$1050	\$525
<input type="checkbox"/>	Four months (37 CFR 1.17(a)(4))	\$1640	\$820
<input type="checkbox"/>	Five months (37 CFR 1.17(a)(5))	\$2230	\$1115
<input type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27.		
<input type="checkbox"/>	A check in the amount of the fee is enclosed.		
<input type="checkbox"/>	Payment by credit card. Form PTO-2038 is attached.		
<input checked="" type="checkbox"/>	The Director has already been authorized to charge fees in this application to a Deposit Account.		
<input checked="" type="checkbox"/>	The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 18-0013		
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.			
I am the <input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).			
<input checked="" type="checkbox"/> attorney or agent of record. Registration Number 24,104 / 40,290			
<input type="checkbox"/> attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34			
_____ Signature		_____ September 23, 2008 Date	
_____ Ronald P. Kananen / Christopher M. Tobin Typed or printed name		_____ (202) 955-3750 Telephone Number	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of 1 forms are submitted.			



PTO/SB/31 (08-08)
Approved for use through 09/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) SON-2842
In re Application of Takashi AOKI, et al.		
Application Number 10/526,490-Conf. #7483		Filed March 4, 2005
For IMAGE PROCESSING APPARATUS AND IMAGE PROCESSING METHOD		
Art Unit 2624		Examiner N. Bitar
<p>Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.</p> <p>The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ <u>510.00</u></p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <u>18-0013</u>.</p> <p><input checked="" type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.</p> <p>WARNING: INFORMATION ON THIS FORM MAY BECOME PUBLIC. CREDIT CARD INFORMATION SHOULD NOT BE INCLUDED ON THIS FORM. PROVIDE CREDIT CARD INFORMATION AND AUTHORIZATION ON PTO-2038.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>24,104 / 40,290</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div style="text-align: right;"> _____ Signature Ronald P. Kananen / Christopher M. Tobin Typed or printed name <u>(202) 955-3750</u> Telephone number <u>September 23, 2008</u> Date</div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>		

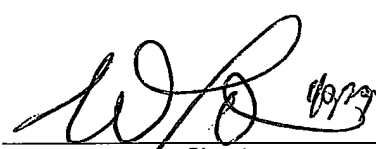


Doc Code: AP.PRE.REQ

PTO/SB/33 (08-08)
Approved for use through 09/30/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SON-2842	
	Application Number 10/526,490-Conf. #7483	Filed March 4, 2005	
	First Named Inventor Takashi AOKI, et al.		
	Art Unit 2624	Examiner N. Bitar	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>24,104 / 40,290</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> _____ Signature <u>Ronald P. Kananen / Christopher M. Tobin</u> Typed or printed name</p> <p>_____ (202) 955-3750 Telephone number <u>September 23, 2008</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			



Docket No.: SON-2842
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takashi AOKI, et al.

Application No.: 10/526,490

Confirmation No.: 7483

Filed: March 4, 2005

Art Unit: 2624

For: IMAGE PROCESSING APPARATUS AND
IMAGE PROCESSING METHOD

Examiner: N. Bitar

REQUEST FOR PRE-APPEAL BRIEF PANEL REVIEW OF FINAL REJECTION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a full and timely response to the Advisory Action mailed on August 23, 2008. Furthermore, Appellant notes that *two petitions are currently pending* with respect to the present application, under 37 C.F.R. § 1.181 and 37 C.F.R. § 1.114.

The rejections found within the Final Office Action are traversed at least for the following reasons, discussed below:

Rejection under 35 U.S.C. § 102

Claims 1-6 have been rejected under 35 U.S.C. § 102 over U.S. Patent No. 4,907,283 to Tanaka et al. ("Tanaka").

Tanaka discloses an optical character search device illustrated in Fig. 1. In Fig. 1, an image is provided to image memory 101, via image input unit 100 and is displayed on display unit 108. Character trimming unit 102 identifies each individual character and determines the x, y corner coordinate, width, height, and degenerate code C, for each character. A user may then use keyboard 105 to perform character string searches on the data to find character sets in the display.

With respect to claim 1, Tanaka fails to teach or suggest *"when a part of image data stored in the memory is trimmed, the controlling means is configured to control the image data reading means so as to read the image data for each column at a time from the memory."*

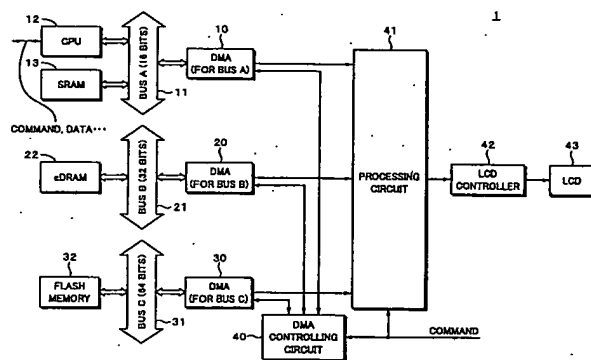


Fig. 3 of the present application illustrates an example embodiment of the present invention.

Processing circuit 41 directly receives data via the plurality of DMA devices (10, 20, 30) and busses (11, 21, 31). The DMA controller 40 acts as a gateway to the various memories (13, 22, 32). To access a trimmed image, the processor circuit 41 issues a command to DMA controller 41 indicating the location of the trimmed image within the original image. In response, the DMA controller 40 issues a series of DMA commands to DMAs (10, 20, 30) to retrieve only the desired portion of the original image one pixel column at a time, without including any undesired portion of the original image.

Page 3 of the Office Action rejects this portion of claim 1 by referring to the image data in Image Memory 101, and later by citing to the image data in the Character Information Table 103.

Tanaka does not disclose how the image data in the image memory is read. Tanaka only discloses that the image data is trimmed and used to create heuristic image character data (i.e., the x-y corner, width, height, degenerate code) stored as a table. While Tanaka discloses that abstract data is stored in a table, Tanaka does not disclose how the data is written or read from memory.

The Office Action responds that:

Applicant argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies "how the image data in the image memory is read" are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 1 recites "*wherein when a part of image data stored in the memory is trimmed, the controlling means is configured to control the image data reading means so as to read the image data for each column at a time from the memory.*" Therefore, claim 1 clearly states that the image from the memory is read by the column.

Tanaka does not teach or suggest that the image data is read from the memory "*each column at a time.*" All that Tanaka discloses is that the image data is read and heuristics are formed based on the image data. While the various columns of Table 103 disclose information pertaining to the data, there is no discussion in Tanaka of how the image data is actually read from memory.

Claim interpretation requires that all elements of a claim be present to reject that claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

While the Office Action correctly states that “claims are interpreted in light of the specification, limitations from the specification are not read into the claims,” the Office Action cannot simply ignore elements of the claims. Unless the Office Action can cite to a specific portion of Tanaka where image data is read from memory “*each column at a time*,” then the rejection must be withdrawn.

The Office Action confuses the term “image data” in the claims. In setting forth the rejection, the Office Action refers to “image data” as the image in the image memory 101, and then refers to “image data” as the character heuristics in the information table.

However, claim 1 is clearly referring to the same “image data” element when reciting the terms “*an image data*” and “*the image data*.” Therefore, the rejection set forth on Page 3, which uses two different data sets in Tanaka to reject the same “*image data*” in claim 1, confuses and incorrectly rejects the “image data” recited in claim 1 on two different pieces of data.

The Office Action responds that:

Finally, Applicant argument that the office action confuses the term in the claims as the data in the image memory 101 and then refers to image data as the character heuristics in the information table. It is true that Tanaka discloses the image data in two different parts since each item area and the corresponding main body page describing the content of the item area are recognized from a page image of the table of contents or index in a document, and the recognized data are stored in a table therefore the image data that are read are stored in a memory so the converted data are the same as the original data but has different codes (see figures 4A and 4B)...

In response, the Office Action has not addressed the issue presented. While the claims identify a single image data that is read and trimmed, the Office Action cites to two different sets of data to reject the same element. While the Office Action contends that this is the same data, this is

clearly not that case. The image itself is clearly separate from the heuristic information extracted from the image data and used to form Table 103.

Furthermore, the claims clearly treat the recited "image data" as the same element that is read out "*each column at a time*." By citing to different data sources, the Office Action ignores the language of the claim. The closest that Tanaka comes to reading image data "a column at a time" is by the suggestion posed by the Office Action that the table 103 is somehow read "a column at a time" by virtue of being a Table. This position distorts the clear meaning of the claim in order to reject the claims over the Tanaka reference.

Accordingly, Tanaka fails teach or suggest various features of claim 1. For similar reasons, Tanaka also fails to teach various features of claim 5. Furthermore, at least for the reason disclosed above, claims 2-4 and 6 overcome Tanaka because they depend on independent claims 1 and 5.

Accordingly, Applicant respectfully requests that the rejection of claims 1-6 under 35 U.S.C. § 102 be withdrawn.

Dated: September 23, 2008

Respectfully submitted,

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Docket No.: SON-2842
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takashi AOKI, et al.

Application No.: 10/526,490

Confirmation No.: 7483

Filed: March 4, 2005

Art Unit: 2624

For: IMAGE PROCESSING APPARATUS AND
IMAGE PROCESSING METHOD

Examiner: N. Bitar

PETITION UNDER 37 C.F.R. §1.144

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Petition under 37 C.F.R. §1.144 requesting review of the Restriction Requirement mailed in the Final Office Action of April 28, 2008, and timely traversed within the After-Final Amendment filed on June 11, 2008.

The Final Office Action of April 28, 2008 includes a restriction requirement under 35 U.S.C. §121. The Office Action further asserts that “[s]ince applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-14 are withdrawn from consideration as being directed to a non-elected invention.”

In response, an election with traverse of that restriction requirement is found within the After-Final Amendment under 37 C.F.R. § 1.116 filed on June 11, 2008.

Page 2 of the Advisory Action mailed on July 25, 2008 maintains the restriction requirement.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper. See 37 C.F.R. §1.144.

RESTRICTION REQUIREMENT

The Final Office Action of April 28, 2008 includes a restriction requirement under 35 U.S.C. §121, which recites:

Newly submitted claims 7-14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

However, claims 7-14 discloses different embodiment of the invention where they teaches a memory module and a processor that issues a controller command to retrieve the trim image and the controller is configured to command the corresponding data reader to read only the trimmed image.

Page 3 of the Final Office Action of April 28, 2008

ELECTION

Applicant was forced to elect claim 1-6 without notice. The Examiner's position for this constructive election was that:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-14 are withdrawn from consideration as being directed to a non-elected invention.

Pages 3-4 of the Final Office Action of April 28, 2008

TRAVERSAL

For the reasons provided hereinbelow, the Restriction Requirement is respectfully traversed.

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why **>each invention< as claimed *>is< either independent or distinct >from the other(s)<; and (B) the reasons >why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons< for insisting upon restriction therebetween as set forth in the following sections.

MPEP § 808

The Examiner has failed to show the inventions to be independent or distinct

Regarding establishing the reasons each invention is either independent or distinct from the others:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. **A mere statement of conclusion is inadequate.** The reasons upon which the conclusion is based should be given.

MPEP § 808.01

The Final Office Action of April 28, 2008 asserts that “[n]ewly submitted claims 7-14 are directed to an invention that is independent or distinct from the invention originally claimed.”

However, the Office Action fails to cite any reasonable basis for any mutually exclusive characteristics between the present claims and claims 7-14. On the contrary, the **only** basis cited for not searching the new claims is the **narrower scope** of the new claims, in comparison to prior claims 1-6.

In setting forth the restriction, the Final Office Action states that:

claims 7-14 discloses different embodiment of the invention where they[sic] teaches *a memory module and a processor that issues a controller command to retrieve the trim image and the controller is configures to command the corresponding data reader to read only the trimmed image*”

Page 3 of Final Office Action (emphasis added).

Regarding the restriction requirements, the Advisory Action of July 25, 2008 further asserts:

Applicant has amended claim 7 and requested the rejoinder of claims 7-14. Note that amended claims 7-14 have never been examined because they were restricted out in the final rejection mailed 04/28/2008. Claim 7 is different

than claim 1 since claim 7 teaches the "control command" on line 8 to retrieve the trim image which is distinct from the teaching of claim 1. Moreover, Claim 1, requires to read image data for each column at a time from a memory while claim 7 requires to read ONLY the trimmed image portion from the memory. Therefore, the two claims are not the same scope and claim 7 is directed to an invention that is independent from the original claims 1-6.

Page 3 of the Advisory Action of July 25, 2008

However, both the Office Action and Advisory Action fail to argue set forth a clear logical basis as to why the claims are "either independent or distinct," thus warranting restriction.

First, the "*memory module*", "*processor*," and "*controller [] configure[d] to command the corresponding data reader to read only the trimmed image*" do not qualify as elements which would create a basis for *an independent or distinct invention*. At best, these elements may arguably recite a claim having *narrower scope* than that cited in claim 1. However, narrower scope cannot form the basis of a restriction. The inventions must be independent and distinct. In the present case, claim 1 simply includes an invention of broader scope than claim 7.

Second, even if claims 7-14 recited a narrower scope than claim 1 for the cited reasons, claim 7 does not have a significantly narrower scope than all of claims 1-6.

With respect to the use of the phrase "*in response to a controller command from a processor*," (which the Office Action cites as a basis for the restriction) claim 2 already recites an "*image processing apparatus ...wherein the controlling means is configured to supply address information...*"

With respect to the use of the phrase "*memory module*," (which the Office Action cites as the basis for the restriction) this feature alone fails to provide a proper or sufficient basis to argue that the original invention is distinct from the elected invention, as there is no possible basis for arguing that claim 1, which recites "*reading means for reading image data from a memory*", is patentably distinct from claim 7 on the basis of the inclusion of a "memory module."

Finally, the phrase “*the controller is configure[d] to command the corresponding data reader to read only the trimmed image*” (which the Office Action cites as the basis for the restriction) is clearly similar to “trimming out a part of image data stored in a memory and transferring the trimming image data” recited in claim 1. Accordingly, claim 1 clearly recites subject matter sufficiently similar to claim 7 to continue prosecution on all the pending claims.

Furthermore, an argument that claims 1-6 and claim 7-14 are directed to different species fails to form the basis for a restriction where one species is obvious over the other. In the present case, elements of claims 7-14 are found throughout claims 1-6. Furthermore, both sets of claims are drawn from a similar example embodiment.

Accordingly, there is no basis for citing distinctness or independence as a basis for a restriction.

The Examiner has failed to show why the invention recited in claim 7-14 would impose an undue burden.

Regarding establishing undue burden, the MPEP recites:

Where the * inventions as claimed are shown to be independent or distinct ... in order to establish reasons for insisting upon restriction, [the examiner] must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) *Separate classification thereof...*

(B) *A separate status in the art when they are classifiable together...*

(C) *A different field of search...*

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, **no reasons exist for dividing among independent or related inventions.**

MPEP § 808.02 (emphasis added)

Even if the invention recited in claims 7-14 were distinct or independent, the basis cited by the Examiner for issuing the restriction fails to qualify as an undue burden.

The cited reason for the present restriction is the “*memory module*”, “*processor*,” and “*controller [] configure[d] to command the corresponding data reader to read only the trimmed image.*”

None of the these additions qualify to as a basis to place claims 7-14 in a “[s]eparate classification thereof...[a] separate status in the art when they are classifiable together...[or a] different field of search” because none of the cited components would place claims 7-14 in a classification outside the “image processing” arts. While these claims may arguably be narrower than claims 1-6, these narrower elements would not move the claimed apparatus to a new art.

As such, claims 7-14 would not place an undue burden on examination.

RELIEF

For the reasons set forth above, Applicant requests that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper restriction.

FEE

No fee is believed to be required in connection with this petition.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: September 23, 2007

Respectfully submitted,

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